

In paragraph 6, the examiner rejects claims 1-16 as unpatentable over Vigneaux U.S. 5,852,435 in view of Ando. The examiner goes on to describe Linzer but applicant suspects that the examiner intends to refer to Vigneaux. The examiner acknowledges that Vigneaux fails to teach a determining means for determining whether the video stream is a digital video stream and relies on Ando for such determining means. As will be discussed in more detail below, applicant believe that this rejection is inconsistent with the withdrawal of the rejection of the claims as unpatentable over Linzer in view of Ando for the reasons set forth in the prior response.

Before discussing the specific rejections over the art, applicant notes that the examiner has made what applicant believes must be regarded as a provisional type double patenting rejection. The examiner notes that the claims conflict with claims 1-16 of application number 10/149,632. Applicant requests that the rejection be held in abeyance until allowable subject matter is indicated since it is impossible to know what claims will be found to be allowable in the two applications prior to allowance of at least one claim, (MPEP 804, B.)

Referring now to the rejection over Linzer in view of Phillips, the examiner acknowledges that Linzer fails to teach means for determining whether the stored [video stream] is a digital video stream but argues that it is noted that using a determining means for determining if a stored video stream is a digital video stream is well known in the art as taught by Phillips (col. 19, lines 1-15). Before considering this argument it will be helpful to briefly review the first two means (claim 1) or steps (claim 10) of applicant's invention and compare them with Phillips. In accordance with applicant's invention, a method is provided for processing a stored video stream. The first step/means is

determining if the stored video stream is a digital video stream. The second step/means is creating a low resolution video stream based on the stored video stream and then, in a third step, storing the low resolution digital video stream at a digital storage medium. In Phillips, a method for editing film is described. The original images are always film images. The images are selectively scanned to high resolution digital images in a scanner 320 and are scanned into a low resolution digital or analog images 412 by a telecine device 410 all as shown in figure 5A. As shown in figure 7, in accordance with one aspect of Phillips, the telecine device 410 may produce the low resolution images in digital or analog form 414. It can be seen that Phillips has already deviated significantly from applicant's claimed invention. In applicant's invention, the low resolution video stream is always digital. As set forth in step C, the low resolution digital video stream is stored at a digital storage medium. The determining step is carried out before the low resolution video stream is created and consequently is carried out on the original high resolution video stream which in accordance with applicant's invention may be either analog or digital but in connection with Phillips is always analog namely film. While Phillips does convert the film to a high resolution digital image 325 by way of scanner 320 (fig. 7) and apply edits to the high resolution digital image, there is never any step of determining if the stored video stream is analog or digital since it is always film.

Furthermore, even if the possibility that Phillips might use an analog or digital low resolution video stream is considered to suggest applicant's step of determining if the stored video stream is a digital video stream, which applicant disputes, Phillips never mentions such a step. Figure 7 of Phillips appears to be the most relevant. As shown in figure 7, the original images are film 105. The telecine device converts the film to low resolution digital or analog video images

which are fed to the digital non-linear editor DNLE 420. Phillips mentions that if the images 414 are not in digital form, DNLE 420 typically employs an analog to digital converter (not shown) to convert such images to digital form for easier manipulation by DFW 810. The absence of the analog digital converter from figure 7 and the absence of any determining step from either figure 7 or the written description suggests that the low resolution images are either digital or analog but whatever they are, they are known in advance and the digital non-linear editor either includes an analog to digital converter or it does not. There is nothing whatsoever in Phillips that suggests that there is ever any uncertainty as to the format of the low resolution video stream or any suggestion of carrying out applicant's step of determining if the stored video stream is digital. Consequently, there is no suggestion in Phillips providing a first means for determining if the stored video is a digital video stream.

Accordingly, there are two major differences between applicant's claimed invention and the disclosure of Linzer and Phillips. First, the combination of Linzer and Phillips is totally silent as to a means for determining if the stored video is a digital video stream, and second, in the combination of Linzer and Phillips the images that are converted to a low resolution video stream are always film thereby eliminating any requirement for determining whether it is digital or analog since film is always analog. To the extent that Phillips shows scanning the film to create high resolution digital images 325, those digital images are never converted to low resolution images but rather the high resolution compositor 330 applies special effects to the high resolution digital images directly and the modified digital images 332 are converted back to film in the film recorder 340.

Accordingly, not only does Phillips not provide what the examiner suggests that it provides, the examiner has not suggested why one skilled in the art would combine Phillips with Linzer or how the combination would produce applicant's claimed invention. What elements of Phillips does the examiner suggest should be substituted for similar elements of Linzer? Why would one skilled in the art make such substitutions? What results would flow from such substitutions? The examiner does not purport to answer any of these questions. All the examiner says that it would have been obvious to modify Linzer with Phillips using a determining means as taught by Phillips (and applicant disagrees that such a determining means is taught) with the system of Linzer for determining if the stored video stream is a digital video stream in order to accurately and properly process the video stream. If Linzer cannot accurately and properly process its video stream as disclosed then Linzer cannot function and the examiner nowhere suggests that this is the case. The examiner has pointed to nothing in Linzer that suggests that there is any place in Linzer's process where it is necessary to determine whether a video stream is digital or not. This is also the case in Phillips by the way. Accordingly, even if Phillips taught a determining means as the examiner suggests, Linzer doesn't need such determining means since it apparently operates entirely effectively without it. If the examiner is suggesting that Linzer requires determining means then he is suggesting that Linzer is non-enabling in its present form and if this is the case, the examiner shouldn't be using Linzer. In summary, Phillips does not show or suggest applicant's determining means, neither Linzer nor Phillips requires applicant's determining means, the combination of Linzer and Phillips would not produce applicant's claimed invention and there is no reason for

making the combination. Accordingly, the rejections as set forth in paragraph 4 and 5 should be withdrawn.

Turning now to the rejection of claims 1-16 as unpatentable over Vigneaux in view of Ando, the examiner merely substitutes Vigneaux for Linzer and Ando for Phillips. Applicant has already discussed Ando in its Appeal Brief. Since the examiner's reliance on Ando is set forth in language that is literally identical to that previously presented, and relies on the same figure and the same description namely figure 19 and col. 23, lines 28-62, applicant repeats the arguments already presented. The examiner points to FIG 19 of Ando and the description appearing at col. 23, lines 28-62. All that Ando describes is an analog to digital converter ADC 1552 which receives an external analog video signal and converts the analog video signal into digital data or which alternatively receives a digital video signal and a digital audio signal which passes through without conversion. Applicant respectfully submits that this is the opposite of the claimed invention. Ando appears to be automatic and has no determining step nor does it include any means for making a determination of whether a stored video stream is digital video stream. Ando simply applies both types of signals to an analog to digital converter which converts analog signals to digital and passes digital signals through without processing.

It might be tempting to presume, as it appears the examiner has presumed, that there must be something in Ando that makes the determination that applicants claim. With respect however this is not the test. Ando never mentions making the determination nor does he mention any apparatus or any other means for making the determination. What Ando does describe in col. 23 does not make a lot of sense. Ando says that when a digital video signal and a digital audio signal are input to ADC 1552 these signals pass through. This

isn't the way that analog to digital converters normally work and applicant respectfully submits that if Ando is to be used as a reference teaching adaptive processing of analog and digital video signals, it falls short of doing so. At most, Ando proposes a method of treating analog and digital signals that is described only in terms of a result, includes no disclosure of a method or apparatus for accomplishing the result and therefore which is ineffective as a reference for teaching applicant's claimed limitations. In order to be effective as a reference, Ando must be enabling for the teaching relied upon and in this case. Ando clearly is not. He says not a word about how the determination suggested to be present by the examiner is made, not a word about the apparatus for making it or any suggestion that would lead one skilled in the art to provide applicant's invention without much more than is included in Ando itself.

The substitution of Vigneaux for Linzer does not help the examiner's position.

Vigneaux appears to relate exclusively to a digital production system (see the Abstract, the Summary of the Invention and the Detailed Description.) The word analog does not even appear in Vigneaux. Since Vigneaux relates entirely to stored digital material, there is no need for applicant's means for determining if the stored video is digital. In Vigneaux, it is always digital. Consequently, not only is the examiner correct that Vigneaux fails to teach a determining means for determining if a stored video stream is a digital video stream, there is no need for such a means because the video in Vigneaux is always digital. Whatever Vigneaux teaches, it fails to teach applicant's means for determining if the stored video is digital because it does not need such a means. Consequently, even if Ando did teach the means for

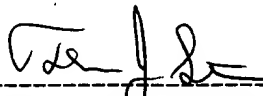
determining, which applicant disputes for the reasons already set forth, the examiner has literally not even attempted to explain why the determining means would be combined with Vigneaux saying only that it would have been obvious to make the combination for determining if the stored video stream is a digital video stream in order to accurately and properly process the video stream which makes no sense since the video stream in Vigneaux is always digital. Consequently, applicant respectfully submits that the rejection over Vigneaux in view of Ando is improper and should be reversed.

Each of the matters raised in the Office Action having been addressed, reconsideration and favorable action are requested.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,



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